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Jerome Azema

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

EXAMINER

GERGISO, TECHANE

ART UNIT

PAPER NUMBER

2437

NOTIFICATION DATE

DELIVERY MODE

06/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/618,873 | Applicant(s) AZEMA ET AL. | |
| | Examiner TECHANE J. GERGISO | Art Unit 2437 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-14,16-19,21-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-14,16-19,21,22 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 23-27 and 29-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 19, 2009 has been entered. 1-3, 5-8, 10-14, 16-19, 21-31 have been examined and are pending.

Election/Restrictions

2. Claims 23-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 13, 2009.

3. Applicant's election with traverse of Invention (I) (claims 1, 6, 12 and 17) in the reply filed on April 13, 2009 is acknowledged. The traversal is on the ground(s) that:

The applicant **added seven addition independent claims** 23, 25, 26, 27, 29, 30 and 31 filed on March 04, 2009 together with a request for continued examination on March 19, 2009; and the applicant has traversed the restriction requirement of these claims by arguing that these added independent claims **do not impose a serious burden** on the examiner **by totally relaying**

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on the prior prosecution history of this application based on the previously performed search history, claim interpretation for scope, boundary and patentability determination of the claims in the previous Office Actions.

This is not found persuasive because:

During examination for the added **independent claims (23-31) in a** request for continued examination under 37 CFR 1.114 filed on March 19, 2009, the examiner made a restriction requirement for claims 1-3, 5-8, 10-14, 16-19, 21-31 by grouping and classifying them into 8 **distinct or independent inventions** which are separately usable.

- (I) Claims 1, 6, 12, and 17 are drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring the processing device hardware** responsive to the configuration parameters to set one or more of: a speed of a hardware component of the processing device, access to one or more otherwise inaccessible memory locations; and it is classified in class 713, subclass 156; and class 713, subclass 1.
- (II) Claim 23 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **restoring performance characteristics of the device** to a predetermined setting; and it is classified in class 713, subclass 156; and class 713, subclass 322.
- (III) Claim 25 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the

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certificate; **configuring the speed of the processing device** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 719, subclass 327.

(IV) Claim 26 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring a memory speed for the processing device** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 711, subclass 1.

(V) Claim 27 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **configuring a bus speed for the processing device** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 710, subclass 100.

(VI) Claim 29 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **selectively enabling or disabling network hardware** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 709, subclass 220.

(VII) Claim 30 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **selectively enabling or disabling audio hardware** responsive to the

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configuration parameters; and it is classified in class 713, subclass 156; and class 719, subclass 322.

(VIII) Claim 31 is drawn to accessing and authenticating a certificate bound to the processing device; reading and authenticating configuration parameters from the certificate; **selectively enabling or disabling video hardware** responsive to the configuration parameters; and it is classified in class 713, subclass 156; and class 719, subclass 323.

For the above non-elected distinct or independent inventions II-VIII (independent claims 23, 25, 26, 27, 29, 30 and 31) filed on March 19, 2009 under 37 CFR 1.114, a through examination to perform claim interpretation for each independent claim scope, boundary and clarity to determine the patentability of each distinct independent claims and an extensive search for each of the independent distinct claimed invention are required unlike the applicant's argument which states a through examination and search has been done in the previous Office Actions during the prosecution. The examiner would like to clear and bring to the applicant's attention that each of the non-elected inventions II-VIII as restricted are different in scope, boundary and patentability from the claimed invention (I) addressed in the previous Office Action during the prosecution.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a **serious search and examination burden** if restriction were not required because one or more of the following reasons apply:

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- (a) the inventions have **acquired a separate status** in the art in view of their **different classification**;
- (b) the inventions have **acquired a separate status** in the art due to their recognized **divergent subject matter**;
- (c) the inventions **require a different field of search** (for example, searching different classes/subclasses or electronic resources and multiple databases , or employing different search queries);
- (d) **the prior art** applicable to one invention would **not likely be applicable** to another invention;
- (e) the inventions are **likely to raise different non-prior art issues** under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

The requirement is still deemed proper and is therefore made FINAL.

Response to Arguments

- 4. Applicant's arguments with respect to claims 1-3, 5-8, 10-14, 16-19, 21-22 and 28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

- 5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 5-8, 10-14, 16-19, 21-22 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Hind et al. (hereinafter referred to as Hind, US. Pat. No.: 6,976,163).

As per claim 1:

Hind discloses a method of configuring a processing device, comprising the steps of:

accessing a certificate bound to the processing device (column 2: lines 40-50: provide updates of firmware (i.e. data stored in a programmable memory device of a processing system) based on rules provided as extensions to certificates associated with an update);

authenticating the certificate (column 3: lines 43-50; validate or authenticate the certificate);

reading configuration parameters from the certificate, if properly authenticated (column 2: lines 60-67; update rules; column 2: lines 40-50; column 4: lines 45-55; update rules as extension of the certificate); and

configuring the processing device hardware responsive to the configuration parameters to set one or more of: a speed of a hardware component of the processing device, access to one or more otherwise inaccessible memory locations (column 1: lines 56-67: Column 10: lines 10-25; In a personal computer, firmware instructions are generally referred to as a Basic Input-Output System (BIOS). A BIOS typically contains hardware diagnostics, code which initializes and enables/disables certain hardware features (for example boot from network, system board sound or display capability, memory parity, I/O bus speed, DMA,

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etc.), and instructions enabling the operating system and application programs to interface with the computer hardware. Parameters governing branches through the initialization code to enable/disable or configure certain hardware features are often stored in battery-backed-up CMOS RAM).

As per claim 6:

Hind discloses a processing device comprising:

processing circuitry (Figure 2: 230; Figure 3: 238);

a memory coupled to the processing circuitry (Figure 3: 236: Programmable Memory);

wherein the processing circuitry:

accesses a certificate bound to the processing device and stored in the memory
(column 2: lines 40-50);

authenticates the certificate (column 3: lines 43-50);

reads configuration parameters from the certificate, if properly authenticated
(column 2: lines 60-67; update rules; column 2: lines 40-50; column 4:
lines 45-55; update rules as extension of the certificate); and

configures the processing device responsive to the configuration parameters to set
one or more of: a speed of a hardware component of the processing
device, access to one or more otherwise inaccessible memory locations
(column 1: lines 56-67; Column 10: lines 10-25; column 14: lines 41-54).

As per claim 12:

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Hind discloses a method of configuring a processing device, comprising the steps of:
accessing a certificate bound to the processing device (column 2: lines 40-50);
authenticating the certificate (column 3: lines 43-50);
reading configuration parameters from a data file associated with the certificate, if the
certificate is properly authenticated (column 2: lines 60-67; update rules; column
2: lines 40-50; column 4: lines 45-55; update rules as extension of the certificate;
Figure 7: Firmware usage rule; column 14: lines 17-35); and
configuring the processing device responsive to the configuration parameters to set one or
more of: a speed of a hardware component of the processing device, access to one
or more otherwise inaccessible memory locations or enablement or disablement of
a hardware component (column 1: lines 56-67; Column 10: lines 10-25; column
14: lines 41-54).

As per claim 17:

Hind discloses a processing device comprising:
processing circuitry (Figure 2: 230; Figure 3: 238);
a memory coupled to the processing circuitry (Figure 3: 236: Programmable Memory);
wherein the processing circuitry:
accesses a certificate bound to the processing device and stored in the memory
(column 2: lines 40-50);
authenticates the certificate (column 3: lines 43-50);

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reads configuration parameters from a data file associated with the certificate, if the certificate is properly authenticated (column 2: lines 60-67; update rules; column 2: lines 40-50; column 4: lines 45-55; update rules as extension of the certificate; Figure 7: Firmware usage rule; column 14: lines 17-35); and;

configures the processing device responsive to the configuration parameters to set one or more of: a speed of a hardware component of the processing device, access to one or more otherwise inaccessible memory locations or the enablement or disablement of a hardware component (column 1: lines 56-67; Column 10: lines 10-25; column 14: lines 41-54).

As per claims 2, 7 and 13:

Hind discloses a method and a processing device, wherein the steps of accessing the certificate, authenticating the certificate, and reading configuration parameters from the certificate are performed whenever the processing device is initially powered (column 1: lines 56-67; Column 10: lines 10-25; column 14: lines 41-54; column 10: lines 1-7).

As per claims 3, 8, 14 and 19:

Hind discloses a method and a processing device, wherein the steps of accessing the certificate, authenticating the certificate, and reading configuration parameters from the certificate are repeated upon a system reset or boot (column 1: lines 56-67; Column 10: lines 10-25; column 14: lines 41-54; column 10: lines 1-7).

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As per claims 5, 10 and 16:

Hind discloses a method and a processing device, further comprising the step of configuring software in the processing device responsive to the configuration parameters (column 2: lines 60-67; update rules; column 2: lines 40-50; column 4: lines 45-55; update rules as extension of the certificate).

As per claim 11:

Hind discloses a processing device, wherein the certificate can be created and modified only by the manufacturer of the processing device (column 15: lines 1-11).

As per claim 16

Hind discloses a method further comprising the step of configuring software in the processing device responsive to the configuration parameters (column 2: lines 60-67; update rules; column 2: lines 40-50; column 4: lines 45-55; update rules as extension of the certificate).

As per claim 18:

Hind discloses a processing device, wherein the processing circuitry accesses the certificate, authenticates the certificate, and reads configuration parameters whenever the processing device is initially powered (column 1: lines 56-67; Column 10: lines 10-25; column 14: lines 41-54; column 10: lines 1-7).

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As per claim 21:

Hind discloses a processing device, wherein the processing circuitry configures software in the processing device responsive to the configuration parameters (column 2: lines 60-67; update rules; column 2: lines 40-50; column 4: lines 45-55; update rules as extension of the certificate).

As per claim 22:

Hind discloses a processing device, wherein the certificate's can be created and modified only by the manufacturer of the processing device (column 15: lines 1-11).

As per claim 28:

Hind discloses a method, wherein the step of configuring the hardware of the processing device includes the step of selectively enabling or disabling operation of one or more hardware features components (column 4: lines 45-60).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the notice of reference cited in form PTO-892 for additional prior art.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TECHANE J. GERGISO whose telephone number is (571)272-

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3784 and fax number is (571) 273-3784. The examiner can normally be reached on 9:00am - 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Techane J. Gergiso/

Examiner, Art Unit 2437